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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,590	07/10/2003	Michael R. Nowak	P/73-43	3640

7590  
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Weiss & Weiss  
310 Old Country Road  
Garden City, NY 11530

12/14/2004

EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/616,590

Applicant(s)

NOWAK, MICHAEL R.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Quigg (US 2002/0004732 A1).

Quigg anticipates a ream wrapper comprising one or more printed manufacturer or retailer coupon or coupon booklets which are included inside the wrapped ream of paper, printed on either the inside or outside of said wrapper, and/or attached to an inside surface or outside surface of said ream wrap (p.3, paragraph 26). The ream wrapper further contains a printed advertisement on the ream wrapper (p.3, paragraph 26). The printed coupons attached to the surface of the ream wrap are inherently attached using adhesive backing as suggested in page 5, paragraph 40. The ream wrap is clear and/or comprises a clear window (p.4, paragraph 39).

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2. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill (USPN 5,645,300).

Hill anticipates a wrapper comprising one or more printed manufacturer or retailer coupons (reference number 23, Figure 1), which are printed on either the inside or outside of said wrapper comprising solid or dotted lines for a user to cut out said coupons and/or perforations precut or pressed into said wrapper (col.4, 1.66 - col.5, 1.7). Note the limitation that the wrapper is a ream wrapper is an intended use limitation in an article claim. Articles are defined only by structure and not merely by stating an intended use of the article. In this case, the wrapper of Hill has the same structural limitations as the ream wrapper and has the ability to wrap around a ream. Therefore, the wrapper of Hill anticipates all of the limitations of claim 3.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quigg (US 2002/0004732 A1) in view of Hill (USPN 5,645,300).

Quigg teaches all that is claimed in claim 3 as shown above and teaches that the promotional material includes a redeemable coupon (p.3, paragraph 26). Quigg fails to explicitly teach that solid or dotted lines and/or perforations are formed around the redeemable coupon to enable the consumer to separate the coupon from the wrapper. However, Hill teaches that it is notoriously well known in the art of providing redeemable coupons in wrappers, to use solid or dotted lines and/or perforations to make the coupons easier to separate from the wrapper. It would have been obvious to one of ordinary skill in

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the art at the time the applicant's invention was made to combine the teaches of Quigg and Hill since each of the aforementioned references are analogous insofar as being directed at wrappers for containing a product.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to apply solid or dotted lines and/or perforations around the coupons of Quigg, in order to make the coupons easier to separate from the wrapper, as taught by Hill.

#### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Boriani et al (US 2003/0089763 A1); Dahlquist (USPN 6,080,094); Countee, Jr. (USPN 5,074,462); Crossman et al (USPN 5,035,515); Bemel (USPN 3,804,323).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be

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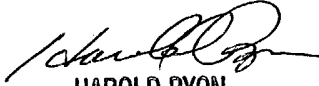
reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB

December 6, 2004

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

12/10/04